

REMARKS

The Applicants respectfully request reconsideration and allowance of claims 1 through 37 in view of the comments set forth below.

I. THE ENCLOSED TERMINAL DISCLAIMER OBVIATES THE DOUBLE PATENTING REJECTIONS

The Examiner rejected claims 1-27, 29-31, and 33-36 under the doctrine of obviousness-type (nonstatutory) double patenting in view of claims 1 through 23 of U.S. Patent No. 6,169,878. Enclosed with this response is a terminal disclaimer under 37 C.F.R. §1.321(c). The Applicants believe that this terminal disclaimer overcomes the nonstatutory double patenting rejections. Thus, the Applicants submit that claims 1-37 are all now in condition for allowance.

II. INFORMATION DISCLOSURE STATEMENT AND INFORMATION ON RELATED LITIGATION

The Applicants are submitting under separate cover an Information Disclosure Statement under 37 C.F.R. §1.97(c) to disclose additional prior art references that were cited in litigation involving the two parent cases for the present application, U.S. Patent No. 5,761,605 (the "605 patent") and U.S. Patent No. 6,169,878 (the "878 patent"). This litigation, styled Northpoint Technology, Ltd. v. MDS America, Inc. and MDS International, S.A.R.L. in the United States District Court for the Southern District of Florida (the "litigation"), involved claim 8 of the 605 patent and claims 1 and 7 of the 878 patent (the "asserted claims"). The defendants in the litigation (the "litigation defendants") argued that five references independently anticipated the

asserted claims, and further argued that the asserted claims were obvious in view of the five references. These references are:

1. Rand Corp., *The Technology Potentials for Satellite Spacing and Frequency Sharing* (1968), (the "Rand reference" or "Rand");
2. Eur. Radiocom. Comm., *Sharing the Band 11.7 Ghz Between ENG/OB and Direct-to-home TV Broadcasting Satellites* (ERC Rep. No. 37, 1995), (the "ERC reference" or "ERC");
3. ITU Radio Regs., Art 27 (1982), (the "ITU reference" or "ITU");
4. Scheeren, *Interference Reduction Techniques for Earth Stations* (1988), (the "Scheeren reference" or "Scheeren"); and
5. Hult, *Sharing the UHF Between Space and Terrestrial Services* (1970), (the "Hult reference" or "Hult").

At the conclusion of the trial, the jury found that the asserted claims (claim 8 of the 605 patent and claims 1 and 7 of the 878 patent) failed to comply with the enablement requirement and were indefinite under §112, that the asserted claims were anticipated by the prior art, and that the asserted claims would have been obvious in view of the prior art. The final judgement in this U.S. District Court case is currently pending appeal by the patent owner to the U.S. Court of Appeals for the Federal Circuit.

The Applicants submit that claims 1 through 37 in this application are clearly allowable over the five references cited above and in the IDS submitted under separate cover.

A. The Rand Reference

The Applicants understand the litigation defendants relied on two sentences from the Rand reference to support the litigation defendants' contention that the asserted claims were anticipated by the Rand reference. The two sentences are as follows:

"Three types of stations must be considered in analyzing such spectrum sharing: terrestrial microwave repeaters and terminals, satellite repeaters, and earth-station terminals."
(Section V of the Rand reference)

1 "If the relative alignment of terrestrial microwave relay and satellite relay antennas is
2 controlled so that either or both do not point at the other, the mutual interference potential could
3 be significantly reduced." (Page 94 of the Rand reference)

4
5 B. The ERC Reference

6 The Applicants understand the litigation defendants relied on a single passage from the
7 ERC reference to support the litigation defendants' contention that the asserted claims were
8 anticipated by the ERC reference. This passage reads:

9 "Whilst the density of domestic receiving installations in the locality of the cordless
10 camera site remains low, co-existence between them and the low power outgoing link from the
11 camera, may be considered possible." (Page 4 of the ERC reference)

12
13 C. The ITU Reference

14 The Applicants understand the litigation defendants relied on a single footnote from the
15 ITU reference to support the litigation defendants' contention that the asserted claims were
16 anticipated by the ITU reference. This passage reads:

17 "For their own protection receiving stations in the fixed or mobile service operating in
18 bands shared with space radiocommunication services (space-to-Earth) should also avoid
19 directing their antennae towards the geostationary-satellite orbit if their sensitivity is sufficiently
20 high that interference from space station transmissions may be significant." (Page RR 27-2 of the
21 ITU reference)

1 D. The Scheeren Reference

2 It is noted that the Scheeren reference was not in evidence in the above-described
3 litigation. The litigation defendants withdrew the Scheeren reference after their expert had
4 testified about the reference. The Applicants understand that the litigation defendants argued that
5 the discussion at pages 3 and 4 of the Scheeren reference anticipated the asserted claims.
6

7 E. The Hult Reference

8 The Applicants understand that the litigation defendants argued that the Hult reference
9 inherently disclosed the antenna directional reception range limitations in the asserted claims.
10 However, the Hult reference does not mention the use of antennas with a directional reception
11 range, but instead suggests using small adaptive antenna arrays that have the capability to null
12 out or not accept or absorb energy from unwanted interfering signals.
13

III. CONCLUSION

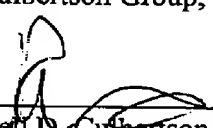
For all of the above reasons the Applicants respectfully request reconsideration and allowance of claims 1 through 37.

If the Examiner should feel that any issue remains as to the allowability of these claims, or that a telephone conference might expedite allowance of the claims, the Examiner may telephone the Applicant's attorney Russell D. Culbertson at the number listed below.

Respectfully submitted,

The Culbertson Group, P.C.

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CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, (Fax No. 703-872-9306) on September 29, 2004.

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